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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,498	07/09/2001	David P. Kippie	05542/008002	5182

22511 7590 12/24/2003

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HOUSTON, TX 77010

EXAMINER

TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/901,498

Applicant(s)

KIPPIE ET AL.

Examiner

Philip C Tucker

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/24/03 has been entered.

### **Claims Interpretation**

2. In the claims applicant has claimed that the polymer is a viscosifying agent, which is true of the applied prior art polymers which provide viscosity to the fluids. Applicant has taught the amine in an amount effective to prevent substantial decomposition of the natural polymer in the claims. The claims are interpreted in view of case law which indicates that a novel intended use, or discovery of an inherent property cannot impart patentability to an old composition (see In re Pearson 181 USPQ 641, In re Zierden 162 USPQ 102, In re Tomlinsin 150 USPQ 623).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 5, 6, 8-11, 13, 14, 16-19, 21, 22, 24-26, 28-34 and 36-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Hanlon et al (4524829).

Hanlon teaches a well treatment composition which comprises cellulose or xanthan polymers and triethanolamine within the scope of the present invention (see Table I).

5. Claims 1-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Glass Jr. (4561985).

Glass teaches a well treatment fluid which comprises a hydroxyethyl cellulose or xanthan and triethanolamine, within the scope of the present invention (see example 14 and whole patent).

6. Claims 1-3, 5, 6, 8-11, 13, 14, 16-19, 21, 22, 24-34, 36-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Baranet (4780223).

Baranet teaches a well treatment fluid which comprises triethanolamine amine and a natural polymer (see Examples).

7. Claims 1-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Mitchell (6227295).

Mitchell teaches a well treatment fluid which comprises amines and natural polymers (see examples and tables).

8. Applicants arguments have been considered but are not deemed persuasive with respect to the prior art. Applicants amendment has overcome the 35 USC 112 rejection. Applicant has first argued that the crosslinking agent is the component which increases the viscosity of the composition. Although the crosslinking agent does contribute to an increase of the composition, compared to a composition without such crosslinker, it is clearly the polymer which is the viscosity increasing agent, since such increases the viscosity of the composition in the absence of the crosslinking agent, but not vice-versa. In whichever case, it is still the polymer, whether crosslinked or not which viscosifies the composition.

9. As noted in the claims interpretation section a novel intended use, or discovery of an inherent property cannot impart patentability to an old composition (see In re Pearson 181 USPQ 641, In re Zierden 162 USPQ 102, In re Tomlinsin 150 USPQ

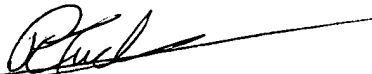
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623). The intended use of the amine to prevent decomposition of the polymer cannot distinguish over the prior art. The prior art teaches the use of the amine at the same levels as taught in the current claims. Applicant has not given any evidence to show that the polymers of the prior art would not also be subject to less decomposition, as stated in the present claims, when exposed to the same amines, such as triethanolamine, as used in the present invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

  
Philip C Tucker  
Primary Examiner  
Art Unit 1712

PCT-2917